

Amendment under 37 C.F.R. § 1.116  
U.S. Application No. 10/730,268

**AMENDMENTS TO THE DRAWINGS**

Applicant submits herewith two formal replacement sheets of drawings for Figures 8A, 8B, 11A and 11B.

Attachment: two Replacement Sheets

**REMARKS**

Claims 1-10 and 12-18 have been examined. Claim 12 has been rejected under 35 U.S.C. § 112, second paragraph, claims 1, 2, 8-10 and 13-18 have been rejected under 35 U.S.C. § 102(b) and claims 3-7 and 12 have been rejected under 35 U.S.C. § 103(a).

**I. Preliminary Matters**

The Examiner indicated that the annotated drawings submitted with the July 24, 2006 Amendment, are acceptable. Accordingly, Applicant submits herewith formal replacement drawings for Figures 8A, 8B, 11A and 11B.

**II. Rejection under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claim 12 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner maintains that the “cut-and-rising portion” does not have antecedent basis in claim 1. Accordingly, Applicant has amended the dependency of claim 12. The rejection is now moot.

**III. Rejections under 35 U.S.C. § 102(b) in view of U.S. Patent No. 6,168,428 to Voudouris (“Voudouris”)**

The Examiner has rejected claims 1, 2, 8-10 and 13-18 under 35 U.S.C. § 102(b) as allegedly being unpatentable over Voudouris.

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites a wall portion which extends upward from an edge of the middle groove and faces the cover portion.

The Examiner maintains that the spaced groove between the wings 116 of Figure 8 of Voudouris discloses the claimed groove. Furthermore, the Examiner maintains that a wall portion is shown in Figures 8 and 9. Applicant submits that the alleged groove of Voudouris is a penetrating groove with no wall portion in the manner claimed. Accordingly, Applicant submits that claim 1 is patentable over the Voudouris reference.

If the Examiner wishes to persist in the rejection of claim 1, Applicant respectfully requests the Examiner to provide an annotated figure of Voudouris which illustrates where the claimed wall portion is deemed to be taught.

**B. Claims 2, 9, 13, 14 and 17**

Applicant submits that claims 2, 9, 13 and 17 are patentable at least by virtue of their dependency.

In addition, since claim 14 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

**C. Claim 8**

Since claim 8 contains features that are analogous to the features recited in claim 1, Applicant submits that claim 8 is patentable for at least analogous reasons as claim 1.

**D. Claims 10, 15, 16 and 18**

Applicant submits that claims 10, 16 and 18 are patentable at least by virtue of their dependency.

In addition, since claim 15 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

**IV. Rejections under 35 U.S.C. § 102(b) in view of U.S. Patent No. 6,776,613 to Orikasa ("Orikasa")**

The Examiner has rejected claims 1, 2, 13, 14 and 17 under 35 U.S.C. § 102(b) as allegedly being anticipated by Orikasa.

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites a wall portion which extends upward from an edge of the middle groove and faces the cover portion.

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The Examiner maintains that the portion between the wings 38B and 38C of Figure 5 of Orikasa discloses the claimed groove. Furthermore, the Examiner maintains that a wall portion is shown in Figures 5-8. Applicant submits that the alleged groove of Orikasa is actually a tip of a tie wing and has no wall portion in the manner claimed. Accordingly, Applicant submits that claim 1 is patentable over the Orikasa reference.

If the Examiner wishes to persist in the rejection of claim 1, Applicant respectfully requests the Examiner to provide an annotated figure of Orikasa which illustrates where the claimed wall portion is deemed to be taught.

**B. Claims 2, 13, 14 and 17**

Applicant submits that claims 2, 13 and 17 are patentable at least by virtue of their dependency.

In addition, since claim 14 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

**V. Rejections under 35 U.S.C. § 102(b) in view of U.S. Patent No. 6,071,119 to Christoff ("Christoff")**

The Examiner has rejected claims 1, 9, 13, 14 and 17 under 35 U.S.C. § 102(b) as allegedly being anticipated by Christoff.

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites a wall portion which extends upward from an edge of the middle groove and faces the cover portion.

The Examiner maintains that the spaced groove between the wings 26 of Figure 2 of Christoff discloses the claimed groove. Furthermore, the Examiner maintains that a wall portion is shown in Figures 3-5. Applicant submits that the alleged groove of Christoff is a penetrating groove with no wall portion in the manner claimed. Accordingly, Applicant submits that claim 1 is patentable over the Christoff reference.

If the Examiner wishes to persist in the rejection of claim 1, Applicant respectfully requests the Examiner to provide an annotated figure of Christoff which illustrates where the claimed wall portion is deemed to be taught.

**B. Claims 9, 13, 14 and 17**

Applicant submits that claims 9, 13 and 17 are patentable at least by virtue of their dependency.

In addition, since claim 14 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

**VI. Rejections under 35 U.S.C. § 103(a) in view of Voudouris and U.S. Patent No. 6,071,118 to Damon (“Damon”)**

The Examiner has rejected claims 3-7 and 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Voudouris in view of Damon.

**A. Claim 3**

Since claim 3 is dependent upon claim 1, and Damon fails to cure the deficient teachings of Voudouris, in regard to claim 1, Applicant submits that claim 3 is patentable at least by virtue of its dependency.

In addition, claim 3 recites that the recess portion is a cut-and-rising portion having a convex portion that protrudes from an outer surface of the clip. The recess portion is operative to catch a clip release tool (claim 1).

The Examiner maintains that element 142 of Voudouris discloses the claimed recess portion. Voudouris discloses, however, that it is the recess 140 that actually receives a clip release tool (col. 11, lines 37-45 and Fig. 11A). Nevertheless, the Examiner acknowledges that Voudouris fails to teach or suggest the claimed convex portion recited in claim 3. Therefore, the Examiner refers to the Damon reference. The Examiner maintains that the elements 37 and 39 of Damon disclose the claimed convex portion.

As set forth in Damon, the rib 37 is provided with a groove 38 that engages with a manipulating tool (col. 8, lines 20-24). The Examiner maintains that it would have been obvious to modify the recess portion of Voudouris with the ribs 37/39 of Damon, “in order to provide an

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engagement means for a manipulating tool as taught by Damon.” (pg. 7 of Office Action). Applicant submits that such statement fails to provide proper motivation to combine the references. For example, the recess 140 of Voudouris is already provided as an engagement means to receive a manipulating tool. There is no proper suggestion or motivation provided by the Examiner, or in either reference, that would motivate one skilled in the art to replace the recess 140 of Voudouris with the rib/groove 37/38 of Damon.

**B. Claims 4-7 and 12**

Since claims 4-7 and 12 are dependent upon claim 1, and Damon fails to cure the deficient teachings of Voudouris, in regard to claim 1, Applicant submits that claims 4-7 and 12 are patentable at least by virtue of their dependency.

**VII. Rejections under 35 U.S.C. § 103(a) in view of Orikasa and Damon**

The Examiner has rejected claims 3-6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orikasa and Damon.

**A. Claim 3**

Since claim 3 is dependent upon claim 1, and Damon fails to cure the deficient teachings of Orikasa, in regard to claim 1, Applicant submits that claim 3 is patentable at least by virtue of its dependency.



In addition, claim 3 recites that the recess portion is a cut-and-rising portion having a convex portion that protrudes from an outer surface of the clip. The recess portion is operative to catch a clip release tool (claim 1).

The Examiner maintains that the releasing recess 25 of Orikasa discloses the claimed recess portion. Orikasa discloses that the releasing recess 25 is provided for catching a desired instrument (Fig. 5; col. 5, lines 18-19). Since Orikasa fails to teach or suggest the claimed convex portion recited in claim 3, the Examiner refers to the Damon reference. As set forth above, the Examiner maintains that the elements 37 and 39 of Damon disclose the claimed convex portion.

The rib 37 of Damon is provided with a groove 38 that engages with a manipulating tool (col. 8, lines 20-24). The Examiner maintains that it would have been obvious to modify the recess portion of Orikasa with the ribs 37/39 of Damon, "in order to provide an engagement means for a manipulating tool as taught by Damon." (pg. 7 of Office Action). Applicant submits that such statement fails to provide proper motivation to combine the references. For example, the recess 25 of Orikasa is already provided as an engagement means to receive a manipulating tool. There is no proper suggestion or motivation provided by the Examiner, or in either reference, that would motivate one skilled in the art to replace the recess 25 of Orikasa with the rib/groove 37/38 of Damon.

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**B. Claims 4-6**

Since claims 4-6 are dependent upon claim 1, and Damon fails to cure the deficient teachings of Orikasa, in regard to claim 1, Applicant submits that claims 4-6 are patentable at least by virtue of their dependency.

**VIII. Rejections under 35 U.S.C. § 103(a) in view of Christoff and Damon**

The Examiner has rejected claims 3-6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Christoff in view of Damon.

**A. Claim 3**

Since claim 3 is dependent upon claim 1, and Damon fails to cure the deficient teachings of Christoff, in regard to claim 1, Applicant submits that claim 3 is patentable at least by virtue of its dependency.

In addition, claim 3 recites that the recess portion is a cut-and-rising portion having a convex portion that protrudes from an outer surface of the clip. The recess portion is operative to catch a clip release tool (claim 1).

The Examiner maintains that the notches 64g and 65g of Christoff disclose the claimed recess. However, such portions are not operative to catch a clip releasing tool, as set forth in claim 1. Rather, the notches 64g and 65g are operative to receive the catch 66g of the clip (Figs. 16, 17; col. 14, lines 45-52). A hand instrument can then be used to release the catch 66g from either of the notches 64g or 65g (col. 15, lines 21-24). Nevertheless, as shown in Figure 16, the

notches 64g and 65g are completely covered by the bracket 20g when the catch 66g is placed in one of the notches. Thus, if the rib/groove 37/38 of Damon replaced the notches, where the groove 38 of Damon is specifically used for engagement with a hand tool, the hand tool would be incapable of accessing the groove since such groove would be covered. Accordingly, one skilled in the art would not be motivated to alter the notches of Christoff with the ribs/groove of Damon.

**B. Claims 4-6**

Since claims 4-6 are dependent upon claim 1, and Damon fails to cure the deficient teachings of Christoff, in regard to claim 1, Applicant submits that claims 4-6 are patentable at least by virtue of their dependency.

**IX. Rejections under 35 U.S.C. § 103(a) in view of Orikasa, Damon, Voudouris and Christoff**

The Examiner has rejected claim 7 under 35 U.S.C. § 103(a) in view of Orikasa, Damon and Voudouris and separately in view of Christoff, Damon and Voudouris. However, since claim 7 is dependent upon claim 1, and the cited references fail to teach or suggest all the features of claim 1, Applicant submits that claim 7 is patentable at least by virtue of its dependency.

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**X. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

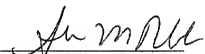
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